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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/742,123	12/19/2003	Jeffrey H. Roffman	VTN-5041	5034
27777	7590	03/08/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/742,123

Applicant(s)

ROFFMAN, JEFFREY H.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/19/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

On the Information Disclosure Statement received December 19, 2003, the cited reference "5,608,741" is not by inventor "Miller et al", is not dated 03/04/97 as cited, and therefore it is believed that the cited reference number is incorrect. For applicant's information, the cited reference number has been changed on the IDS by the examiner to "5,608,471" which is by inventor "Miller et al", is dated 03/04/97 and is believed to be the intended reference by applicant. If a different reference was intended for consideration then it is suggested that it be resubmitted on a subsequent IDS statement.

Claim Rejections - 35 USC § 112

Claims 1 and 6-10 (and dependent claims 2-5 and 11-14) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 9-10, applicant is claiming a "progressive power zone" and "a transition region" between the distance and near vision power regions. However, applicant further claims that the substantially opaque ring obscures light transmission through the transition region and defines "substantially opaque" in the specification as "to 100%" (page 3, second paragraph) thereby rendering the claims vague and indefinite. Specifically, if the ring is 100% opaque and completely covering the transition region (as is disclosed in the specification) then the lens will have no transition region and

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therefore will not be a progressive lens having a progressive power zone. It is therefore not clear what applicant means by "having a progressive power zone" and "comprising a transition region" when applicant states that the opaque ring can be 100% opaque thereby completely obscuring the transition region i.e. completely obscuring the progressive power zone. The lack of clarity renders the claims vague and indefinite.

In reference to claims 6-8, applicant is claiming an "intermediate vision power region" however, similar to the above rejection, this region is disclosed in the specification as between the distance and near vision regions. Similar to the rejection above, if the region between the distance and near can be completely obscured i.e. 100% opaque, then the lens will not have intermediate power and for the same reason above the claims are vague and indefinite.

In further reference to claims 7-8, these claims partly depend from claim 1, and therefore the claimed "intermediate power region" lacks an antecedent basis creating a lack of clarity. It is not clear if applicant is claiming that the intermediate power region is within the progressive power zone (as in claim 6) or if it can be located in another portion of the lens and the lack of antecedent basis and lack of clarity renders the claims vague and indefinite. For purposes of examination it is assumed that claims 7-8 meant to depend only from claim 6 and not claims 1 or 6.

Claim Objections

Claims 9-11 are objected to because of the following informalities:

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1. In reference to claims 9 and 10, line 1 of each claim, "the step" (singular) should be corrected to "the steps" (plural) since more than one step is being claimed; and

2. In reference to claim 11, line 2, "on the len" should be corrected to "on the lens" to correct an apparent inadvertent error.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-7, 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Xu et al patent number 5,980,040.

Xu et al reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract); comprising an optic zone comprising distance vision power region (Figure 1, "12" column 3, line 31, column 4, line 51 i.e. outside of the annular region powered to correct for distant objects); a near vision power region (Figure 1, "20", column 3, lines 26-32, column 4, line 54 i.e. the central aperture region can be powered to correct for near objects); a region there between with a substantially opaque ring obscuring light through this between region (Figure 1, "18", i.e. the annular region, column 3, lines 25-36,

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column 5, lines 25-32). Since Xu et al discloses that the opaque region can be 100% opaque (column 5, lines 25-32) then, with reference to those claims which do not claim "substantially opaque" as less than 100%, the claimed "progressive power zone", the claimed "transition" and the claimed "intermediate power region" have not been given patentable weight because, similar to applicant's invention there will be no progressive power, no transition, and no intermediate power if this region is completely obscured. Xu et al further discloses the opaque ring diameter of about 0.7 to about 1.2 mm (column 5, line 8); the optic zone on one of the front or back surfaces of the lens (Figure 1, column 4, lines 35-42); the power regions comprising spherical powers (column 3, lines 24-36, i.e. correcting for distance and near correction); the opaque ring coated or printed onto a surface of the lens (column 5, lines 25-32); and incorporating a ring-shaped layer of material within a lens material (column 5, lines 25-32).

Claims 1, 3, 5-7, and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wesley patent number 3,794,414.

Wesley reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract) comprising an optic zone comprising a distance vision power region (Figure 10, "13", column 3, lines 9-30, column 5, lines 9-17); a near vision power region (Figure 10, the concentric rings and column 3, line 9, column 5, lines 9-17); a region there between with a substantially opaque ring obscuring light through this between region (column 3, lines 9-30, column 5, lines 9-17). Since Wesley discloses the opaque regions as 100% opaque (column 2, line 36 to column 3, line 30) then, with reference to

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those claims which do not claim "substantially opaque" as less than 100%, the claimed "progressive power zone", the claimed "transition" and the claimed "intermediate power region" have not been given patentable weight because, similar to applicant's invention there will be no progressive power, no transition, and no intermediate power if this region is completely obscured. Wesley further discloses the opaque ring diameter of about 0.7 to about 1.2 mm (column 3, line 50); the optic zone on one of the front or back surfaces of the lens (Figure 10, column 2, line 36 to column 3, line 30, column 5, lines 9-17); and the power regions comprising spherical powers (column 2, line 36 to column 3, line 30, column 5, lines 9-17 i.e. correcting for distance and near correction).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu et al in view of Legerton et al patent number 5,662,706.

With reference to claim 4, Xu et al discloses as is set forth above including that the opacity of the ring can vary within the lens (column 5, line 38); but does not specifically disclose the opaque ring increasing in opacity from a periphery of the ring to an innermost diameter. Legerton teaches that in a contact lens providing near and distant vision correction and which uses an opaque region

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similar to the lens of Xu et al (Legerton, column 2, lines 28-56), that it is desirable for the opaque region to increase in opacity from a periphery to an innermost diameter for the purpose of reducing a halo effect within the lens (column 2, line 28 to column 3, line 43). Therefore, with reference to claim 4, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the opaque ring of the contact lens of Xu et al increasing in opacity from a periphery of the ring to an innermost diameter since Legerton teaches of the desirability of this feature for the purpose of reducing a halo effect within the lens.

With reference to claims 12 and 14, Xu et al discloses as is set forth above but does not specifically disclose the opaque ring formed by molding or etching as claimed. Legerton teaches that in a contact lens providing near and distant vision correction and which uses an opaque region similar to the lens of Xu et al (Legerton, column 2, lines 28-56), that the opaque ring can be formed by coating or printing, molding, incorporating a ring-shaped material within the lens, or etching for the purpose of providing an improved means of forming an opaque ring portion on a contact lens (column 5, line 49, column 6, lines 22-44, column 7, lines 17-29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the opaque ring of Xu et al formed by molding or etching, since Legerton teaches of the desirability of using one of these methods for the purpose of providing an improved means of forming an opaque ring portion on a contact lens.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xu et al or Wesley in view of Roffman et al patent number 5,805,260.

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Xu et al and Wesley disclose as is set forth above but do not specifically disclose the lens power regions comprising toric powers. Roffman et al teaches that in a multifocal contact lens, that it is desirable for the power regions to comprise toric powers for the purpose of additionally providing astigmatic correction (column 1, lines 9-32, column 3, lines 6-21). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the power regions of Xu et al or Wesley as comprising toric powers since Roffman et al teaches that in a multifocal contact lens, that it is desirable for the power regions to comprise toric powers for the purpose of additionally providing astigmatic correction.

Prior Art Citations

Miller et al patent number 5,245,367 and Miller et al patent number 6,554,424 are being cited herein to show contact lenses that would have read on a number of the above rejected claims, however, such rejections would have been repetitive.

Allowable Subject Matter

Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with

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reference to claim 2, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing features in combination with the other limitations, the claimed progressive power zone and transition region between the distance and near vision power regions, and the claimed substantially opaque ring comprising an opacity of about 75% to about 95%.

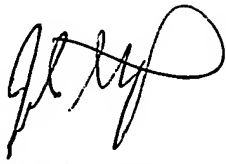
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'JMS', with a large, stylized loop at the end.

Jordan M. Schwartz
Primary Examiner
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February 24, 2005